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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,067	05/25/2006	Nicholas James Robinson	7251/95977	7092
24628 7590 03/15/2010 Husch Blackwell Sanders, LLP Husch Blackwell Sanders LLP Welsh & Katz 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606				
EXAMINER				
KIM, ANDREW				
ART UNIT		PAPER NUMBER		
3714				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/564,067

**Applicant(s)**

ROBINSON, NICHOLAS JAMES

**Examiner**

ANDREW KIM

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-9, 11, 13-26 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 10 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-510/510a)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_
- 7) ☐ Notice of Informal Patent Application
- 8) ☐ Paper No(s)/Mail Date 3/16/06, 5/12/06, 7/16/07

***Drawings***

**DETAILED ACTION**

1. The drawings are objected to because Figs. 5a and 5b are too dark and one cannot clearly see where items 90, 92, 84 and 88 are referred to. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 14, 16 and 20, the antecedent basis for “said groups of elements” (line 2 of claims 14 and 16) and “trail element group” (as per claim 20) has not been clearly set forth.

Claims 15 and 17-19 are rejected for incorporating the above errors from their respective parent claims by dependency.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed method and computer program embedded in a storage medium do not ensure that the process is limited to a particular practical application, hence, it do not pass the machine-or-transformation test; or it do not required machine implementation or do not cause a transformation, hence, it also do not pass the particular transform to a particular article to a different state or thing test. Claiming a processor programmed to perform the method steps or claiming a non-transitory computer readable medium containing a computer program would obviate this rejection. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject

matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. §101, Aug. 24,2009.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-5, 8, 11, 13, 20, 21 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by DeMar et al (US Pub. No. 2002/0132659 A1).**

Regarding claims 1, 25 and 26, DeMar et al discloses a gaming system (as per claim 1) or a method of controlling a gaming system (as per claim 25) comprising: means configured to establish a trail comprised of a succession of trail elements (fig. 3) of which at least one or more are associated with a prize (fig. 6, paragraph(s) 63), progression from one element to another along said trail being dependent upon the completion of tasks by a punter in the course of playing a game (paragraph [0005], “a gaming machine with a feature allowing the player to select a game token”; paragraph [0046], “In one embodiment, the player selects the number of paylines (between one and nine) to play by pressing one of the five buttons in the top row 28 or by using the “Select Lines” key 34 on the video display 12”; paragraph [0060], “the player ‘rolls’ a pair of dice by touching a ‘Roll Dice’ key”); means for determining, at the outset of a said game, the trail element to which the punter could progress in the course of playing the game (paragraph [0061], “In one embodiment, the bonus game continues with consecutive rolls of the

dice, with the player collecting various amounts corresponding to the landing stations determined by the rolls of dice, until the player's token has completed one trip around the game board"); and means for controlling the provision of tasks for completion by the punter in the course of the game, said controlling means being configured to ensure that the punter is not provided with a number of tasks that, if completed, would enable the punter to progress to a trail element beyond that which the punter has been predetermined by said determining means to attain (paragraph [0061], "In one embodiment, the bonus game continues with consecutive rolls of the dice, with the player collecting various amounts corresponding to the landing stations determined by the rolls of dice, until the player's token has completed one trip around the game board").

Regarding claim 2, DeMar et al discloses wherein said establishing means is configured to sub-divide said trail into groups of one or more trail elements (paragraph [0063]).

Regarding claim 3, DeMar et al discloses wherein said groups of elements comprise at least one group which is not associated with a prize, and one or more prize winning groups that are each associated with a prize (paragraph [0063]).

Regarding claim 4, DeMar et al discloses comprising a plurality of prize winning groups, wherein successive prize winning groups are associated with a prize that is more valuable than the prize associated with a preceding prize winning group (table A-2 and A-3).

Regarding claim 5, DeMar et al discloses further comprising a jackpot group comprised of one or more trail elements, said jackpot group being associated with a jackpot prize (table A-3, park place and boardwalk and paragraph [0132]).

Regarding claim 8, DeMar et al discloses wherein said jackpot comprises a fixed amount (table A-3, park place and boardwalk and paragraph [0132]).

Regarding claim 11, DeMar et al discloses wherein said determining means comprises means for generating, at least substantially at random, a number that corresponds to the trail element to which the punter could potentially progress in the course of playing the game (paragraph [0060], dice roll).

Regarding claim 13, DeMar et al discloses wherein a said game is sub-divided into a number of levels, and said controlling means comprises means for generating, at least substantially at random, a number that corresponds to the number of tasks to be provided for completion in the course of a level of the game (Fig. 3, teach side of the board is a level and the dice roll corresponds to the number of other rolls are needed to complete each side of the game board).

Regarding claim 20, DeMar et al discloses wherein a punter is returned to the first element of a trail element group at the end of a level if said punter has not completed sufficient tasks to progress to the next trail element group (paragraph [0007], the player must go to jail if a get out of jail card was not obtained).

Regarding claim 21, DeMar et al discloses wherein a said punter who has completed one or more tasks and has qualified for a said prize is provided with an opportunity to collect said prize (paragraph [0057], the bonus game is triggered when a special outcome occurs in the basic game).

Regarding claim 24, DeMar et al discloses a system implemented in an arcade machine, an interactive television system (terrestrial or satellite), a mobile telephone or portable digital assistant, or a gaming console (Fig. 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 9, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMar et al (US Pub. No. 2002/0132659 A1).**

Regarding claim 9, DeMar et al substantially discloses the invention as claimed but fails to explicitly teach that said jackpot comprises a progressive jackpot. However, it was notoriously well known in the art at the time of the invention to provide progressive jackpots to enable players to play for very substantial amounts (several millions of dollars). Doing so increases player appeal because a player sensing he/she may win millions of dollars can be much more willing to gamble money for the chance to win the large amount.

Regarding claims 22 and 23, DeMar et al substantially discloses the invention as claimed but fails to explicitly teach means of a computing resource and a game server, interconnected by



means of a communications network wherein each of the computing resource and the game server include software operable, when executed in an execution environment, to implement one or more aspects of the functionality herein described. However, it is notoriously well known in the art to combine gaming machines with networks and game servers with software code to player track the players on each of the machines or to provide promotions to frequent users or enable multiplayer games or enable very substantial progressive jackpots.

#### ***Allowable Subject Matter***

Claims 6, 7, 10 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14-19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW KIM whose telephone number is (571)272-1691. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Cheng can be reached on 571-272-4433. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joe H Cheng/  
Supervisory Patent Examiner  
Art Unit 3714

3/15/2010 /A. K./  
Examiner, Art Unit 3714